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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,828

04/16/2004

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MNOAP001DIV

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04/01/2008

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,828	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 5, 14-16, 18-44, 48, 49, 61, 62 and 65-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 17, 45-47 and 50-60 is/are rejected.
- 7) ☒ Claim(s) 63 and 64 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2008 has been entered.

***Election/Restrictions***

Claims 18-44, 48, 49, 61, 62 and 65-71 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 26, 2006. Additionally, claim 5 is withdrawn as being directed to the non-elected species of Figure 4, and claims 14-16 are withdrawn as being directed to the non-elected species of Figure 8.

***Specification***

The disclosure is objected to because of the following informalities: the first sentence of the specification should be amended to provide the most current status (i.e. US Patent Number) for the related application(s).

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-13, 17, 45-47, 50-54, 59 and 60 are rejected under 35

U.S.C. 102(b) as being anticipated by Munro (5,437,665).

Munro discloses a tissue severing device that comprises a guide (3) comprising to co-linear, co-extensive guide lumens (8, 8') extending through the guide and terminating in distal tips at an angle with respect to the guide axis (Figure 3 and Figure 9). A cutting tool (7) is contained in the guide and forms a cutting loop. There is an extension means (24) that controls the extension of the cutting loop from the guide member, and deployment of the cutting loop also controls the width of the cutting loop. There is a handle (1) at the proximal region of the device, the handle including the extension means and width adjuster (24) which passes therethrough and is attached to a control (13) connected to the extension means. The cutting loop is connected to an RF source and made from an alloy such as titanium (col. 8, lines 60+). The guide lumens (8,8') are connected to each other (see Figure 5) and are provided in a tubular shaft that includes accessory lumens (Figure 12B). Munro also disclose a means (42) to connect the lumens to a suction source and an irrigation source. The distal opening of the shaft is deemed to be the primary window through which the cutting tool extends and retracts.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro ('665) in view of the teaching of Maslanka (4,503,855).

The Munro device has been addressed previously. Munro fails to disclose that the shaft member is sharpened to facilitate the penetration of tissue.

Maslanka discloses an analogous extendable wire loop cutting device and specifically teach that it is advantageous to provide the outer sheath member (1) with sharpened tip to facilitate tissue penetration.

To have provided the Munro device with a sharpened tip to facilitate penetration of the device through tissue to the intended site would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Maslanka.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro ('665) and Maslanka ('855) as applied to claim 57 above, and further in view of the teaching of Rydell (5,085,659).

The combination of the Maslanka teaching with the Munro device has been addressed. Maslanka provides a sharpened tip on the device, but fails to disclose an electrode on the sheath member.

Rydell disclose another tissue cutting and removal device that includes a an electrode deployable from a shaft. In particular, Rydell teach that it is known to provide

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the sheath member with an electrode such that a bipolar electrode pair is provide for treating tissue.

To have provided the Munro device, as modified by the teaching of Maslanka, with an electrode on the sheath member to provide for bipolar treatment of tissue would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Rydell.

### ***Allowable Subject Matter***

Claims 63 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant has made no amendments nor made any arguments in response to the final Office action of August 16, 2007. As such, the instant Office action is a substantial repeat of the Office action of August 16, 2007.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/  
Primary Examiner, Art Unit 3739